

REMARKS**[01] Protest for Lack of Substantive Response to Traversals**

[02] Applicant protests the lack of a response to the substance of Applicant's traversals presented in the remarks to Amendment A. The outstanding Office Action deems those traversals moot since the grounds of rejection have been changed from anticipation to obviousness. However, the arguments supporting the rejections are very much the same except that as to Claim 1, a claim element formerly considered to be disclosed by the primary reference is now considered to be disclosed by a secondary reference. In fact, the present arguments favoring rejection of Claims 2-14 are verbatim copies of the prior arguments except that the phrase "Biffar teaches" has been changed to "Biffar and Rose teach".

[03] Every argument in support of the outstanding obviousness rejections is addressed effectively by the arguments for traversal presented in the remarks to Amendment A. If the arguments for traversal had been given due consideration, the grounds for rejection would have been more fully developed or the application would have been allowed. In either case, Applicant has been disadvantaged. Accordingly, Applicant respectfully requests the next Office Action not be made final.

[04] Obviousness Rejection

[05] All pending claims are rejected as obvious in view of U.S. Patent No. 6,397,212 to Biffar, "Biffar" herein, as modified according to the teachings of U.S. Patent No. 5,724,567 to Rose et al., "Rose" herein. The rejections are traversed as detailed below.

[06] Claim 1--Prioritizing a single item

[07] Claim 1 specifies a method in which search items returned in response to a user's search request are prioritized. Biffar teaches a method in which a single item ("...the search engine always presents a complete holistic result", Biffar, abstract, first sentence) is returned in response to a search request. The holistic result is both an essential feature and advantage of Biffar's method.

[08] The Office Action concedes that Biffar does not disclose prioritizing this single item. Indeed, it is nonsensical to contemplate prioritizing a single item, as prioritization requires two or more items. Nonetheless, the Office Action asserts that Rose teaches modifying Biffar so that this single item is prioritized to expand and enhance Biffar's method. Rose nowhere teaches how to prioritize a single item. Furthermore, Rose does not even address prioritizing items returned in response to a user's search request. Clearly, Rose's references to prioritization contemplate situations in which two or more items are available for prioritization.

[09] Since Rose does not teach prioritizing a single item, Rose cannot suggest modifying Biffar to incorporate this ability. Accordingly, the proposed modification of Biffar according to Rose is impossible. As all outstanding rejections are based on this impossibility, the rejections should be withdrawn and all claims allowed.

[10] Claim 1--Failure of Motivation to Combine

[11] The Office Action asserts that the motivation to combine Biffar and Rose would be to expand and enhanced Biffar's method, of responding to a user search request. However, Rose does not teach a method for expanding or enhancing a method of responding

to a user search request. In fact, Rose's information access system is contrasted with systems such as Biffar's in that no user search request is required for items to be returned. In other words, if one were to modify Biffar in accordance with Rose's teachings, the result would not respond to user requests as required by Claim 1. The attempt in the Office Action to ignore the main teaching of Rose while incorporating a detail of Rose constitutes an improper use of hindsight gleaned from the present application.

[12] Claim 2 -- Biffar Does Not Disclose A Community

[13] Claim 2 requires a step of assigning a user to a community. The Office Action purports to find this limitation in several places in Biffar. Biffar's abstract discloses the generation of user profiles, but does not disclose assigning a user to a community as required by Claim 2. The Office Action recites Col. 7, lines 49-61. This passage discusses how Biffar's search engine learns about a user and combines profiles of different users. However, there is no mention of assigning a user to a community. The Office Action also recites Col. 2, line 56-Col. 3, line 14. This is a background discussion on how a human salesman might operate, not a disclosure of how Biffar's embodiment operates. There is no discussion of assigning a user to a community and no prioritization of items returned in response to a query. Applicant requests that the Examiner, if he persists in this ground of rejection, make explicit how the "community" limitations of Claim 1 can be found in Biffar given the absence of that term from Biffar.

[14] Claim 2 also requires assignment of a search request to a search query. The Office Action purports to find this limitation in Biffar's Figs. 3 and 4. However, these figures do not depict the assignment of a search request to a search query. Instead, these figures appear to show a form that forces a user query into a predefined format so that no separate step of assigning a search request to a search query is required as called for by Claim 2.

[15] Claim 2 also requires submission of a query so as to yield a set of response items. The Office Action purports to find this limitation in the abstract and in Col. 7, line 62 to Col. 8 line 7. However, this limitation does not appear in either of these passages.

[16] Finally, Claim 2 requires prioritization according to prior search requests by a community. As noted above, Biffar does not disclose prioritization of returned items, and does not disclose a community. The Office Action purports to find this limitation at Biffar, Col. 11, lines 41-45. This passage discloses an algorithm for selecting a single response item, but not prioritizing multiple response items. While the word "priority" is used, it relates to characteristics, not to returned items.

[17] Claim 3

[18] Claim 3 requires tracking and storing of indications of user interest. The Office Action purports to find this limitation disclosed at Col. 11, line 62 to Col. 12, line 10. This cited passage describes some user actions, but does not disclose that they are tracked and stored.

[19] Claim 4

[20] Claim 4 requires the use of the results defined in Claim 3 in subsequent searches by other users assigned to the same community. Since Biffar does not disclose assigning users to a community, this limitation cannot be disclosed by Biffar. Nonetheless, the Office Action purports to find this limitation disclosed at Biffar, Col. 11, lines 54-62. However, this section refers solely to a single user--no mention is made of how the results for one user might affect the results for another user.

[21] Claim 5

[22] Claim 5 requires priority be given to a child community over a parent community. The Office Action purports to find this limitation met at Biffar, Col. 4, lines 28-67. Most of this section relates solely to an Item database, and has nothing to do with user communities. Col. 4, lines 65-66 do mention user specific item descriptors, but these do not relate to assigning a user to a community or to prioritizing responses.

[23] Claim 6

[24] Claim 6 requires assigning a user to a community as a function of indications of interest. The Office Action purports to find this limitation met at Biffar, Col. 5, lines 4-9. This passage does relate to database hierarchies, but these are of item characteristics, not user communities.

[25] Claim 7

[26] Claim 7 requires community assignment by user selection. The Office Action purports to find this limitation met at Biffar, Col. 3, lines 25-35. This section parallels the abstract and characterizes the search engine as "self personalizing". There is nothing in this passage that discloses a user selecting a community.

[27] Claim 8

[28] Claim 8 requires a user be assigned to a community based on a pre-existing user profile. The Office Action purports to find this limitation met at Biffar, Col., 4, lines 28-65. As discussed above with respect to Claim 5, this section describes the item database, not a search engine or method. There is nothing in this section that relates to assigning a user to a community.

[29] Claim 9

[30] Claim 9 requires, among other elements, a community assigner and the prioritizer, neither of which has counterparts in Biffar. The Office Action does not identify where Biffar discloses the limitations of Claim 9. However, it is clear that Biffar does not disclose the community assigner or the prioritizer.

[31] Claim 10

[32] Claim 10 requires a tracker for tracking indications of user interest to be used by a prioritizer. The Office Action purports to find this limitation at Biffar, Col. 7, lines 54-61. This passage appears to disclose user interest tracking used to develop a user profile, but does not disclose using the results to prioritize items returned in response to a search query.

[33] Claim 11

[34] Claim 11 requires a user be assigned to a community as a function of indications of interest. The Office Action purports to find this limitation at Biffar, Col. 8, lines 35-56. However, this passage does not mention assigning a user to a community nor does it mention indications of interest.

[35] Claim 12

[36] Claim 12 specifies four database fields: hit counts, hit-count values, query contexts, and a user and/or community field. The Office Action purports to find these limitations met by Biffar Fig. 5. However, none of the four claimed fields are illustrated in Fig. 5. Note that since Claim 12 do not require "prioritization", the teachings of Rose are irrelevant here (and for Claims 13 and 14). Applicant hereby requests that if this rejection of Claim 12 is reasserted, the Examiner specify with particularity how the Claimed elements can be found in Biffar, Fig. 5,

[37] Claim 13

[38] Claim 13 requires a decay field for indicating times associated with hit counts. The Office Action asserts that this limitation is addressed in the rejection of one of the preceding claims. However, none of the preceding claims have a limitation analogous to this decay limitation. Accordingly, there is no basis for the rejection of Claim 13.

[39] Claim 14

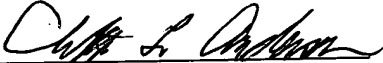
[40] Claim 14 requires a periodic update to community record counts. The Office Action asserts that this limitation is addressed in the context of the rejections of preceding claims. However, this

limitation has no analog in the preceding claims. Hence, there is no valid rejection of Claim 14.

[41] CONCLUSION

[42] The present rejections for obviousness differ from the previous rejections for anticipation only in that a secondary reference (Rose) is used to show prioritization of items. Accordingly, the traversals herein track those in the remarks to Amendment A. Also, the addition of Rose does not favor rejection as Rose does not teach how to prioritize the single item returned in response to a query as taught by Biffar. As the Examiner was unable to respond substantively to those traversals, they should be deemed uncontested and the application should be allowed. Accordingly, Applicant respectfully requests allowance of the application in its current form.

Respectfully submitted


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